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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,708	05/26/2000	Masahiro Ohmori	Q54488	7789

7590 06/21/2002

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EXAMINER

BOS, STEVEN J

ART UNIT PAPER NUMBER

1754

DATE MAILED: 06/21/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-14

Office Action Summary

Application No.
09/579,708

Applicant(s)
Ohmori et al

Examiner
Steven Bos

Art Unit
1754



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 23, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) 2, 5, 7-13, 15, and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 14, and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

Art Unit: 1754

The request filed on May 23, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/579708 is acceptable and a CPA has been established. An action on the CPA follows.

Claims 2-5,7-13,15,16 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 5.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,6,14,17-19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the metal salt being strontium chloride 6 hydrate, does not reasonably provide enablement for "a metal salt comprising at least one of Ca, Sr, Ba, Pb, or Mg". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Instant example 4 upon which applicant relies for support does not support the breadth of the instant claims.

Claims 1,6,14,17-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey

Art Unit: 1754

to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, the ranges of “28 to about 200 m²/g” and “about 10 to 50 nm” are new matter.

In claim 6, the range of “28 to about 200 m²/g” is new matter.

In claim 17, the range of “28 to about 200 m²/g” is new matter.

Claims 6,17,19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 6, 17, “allowing ... to react with a metal salt” is awkward and confusing and might be rephrased as --reacting ... with a metal salt--.

In claims 6,17, the claims are awkward and confusing because the general formula (I) and the wherein clause are located at the end of the claims. They should be relocated next to the recitation “general formula (I).”

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,6,14,17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 06-305729 or JP 11-228139 or JP 07-069635 or JP 5-178617 or JP 6-316414 or JP 8-119745.

JP 06-305729 or JP 11-228139 or JP 07-069635 or JP 5-178617 or JP 6-316414 or JP 8-119745 each teach or at least suggest the instantly claimed product having the instantly claimed characteristics. See the search report for corresponding WO 00/35811 and the abstract of each of JP '745 and JP '414 and JP '617.

Any difference imparted by the product by process limitations would have been obvious to one having ordinary skill in the art at the time the invention was made because where the examiner has found a substantially similar product as in the applied prior art the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show the same process of making, *In re Brown*, 173 USPQ 685, *In re Fessmann*, 180 USPQ 324, *In re Spada*, 15 USPQ2d 1655, *In re Fitzgerald*, 205 USPQ 594, and MPEP 2113.

Where the examiner has found a substantially similar product as in the applied prior art the burden of proof is shifted to the applicant to establish that their product is patentably distinct, see *In re Best*, 195 USPQ 430.

Claims 6,17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe '031 or JP 7-291607.

Watanabe and JP '607 each teach or at least suggest the instantly claimed perovskite product having the instantly claimed product characteristics. See cols. 2-3 of Watanabe and paragraph 38 of JP '607.

Any difference imparted by the product by process limitations would have been obvious to one having ordinary skill in the art at the time the invention was made because where the examiner has found a substantially similar product as in the applied prior art the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show the same process of making, *In re Brown*, 173 USPQ 685, *In re Fessmann*, 180 USPQ 324, *In re Spada*, 15 USPQ2d 1655, *In re Fitzgerald*, 205 USPQ 594, and MPEP 2113.

Where the examiner has found a substantially similar product as in the applied prior art the burden of proof is shifted to the applicant to establish that their product is patentably distinct, see *In re Best*, 195 USPQ 430.

Applicant's arguments filed April 23, 2002 have been fully considered but they are not persuasive.

JP '729 and JP '635 still do not exclude the presence of SO_3 since the claims do not have consisting of language therefore the claims are open to anything and everything including SO_3 .

The instant Figures cannot be relied upon to show what the specific surface areas are or are "about".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Bos whose telephone number is (703) 308-2537. The examiner is on the increased flexitime program schedule. The FAX No. for After Final amendments is 703-872-9311; for all others it is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read "St Bos", is positioned above the printed name.

Steven Bos
Primary Examiner
Art Unit 1754